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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/724,439	11/28/2003	Murry R. Nielsen	RR-559	1226

20427 7590 06/02/2004

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EXAMINER

PECHHOLD, ALEXANDRA K

ART UNIT	PAPER NUMBER
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3671

DATE MAILED: 06/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/724,439

Applicant(s)

NIELSEN, MURRY R.

Examiner

Alexandra K Pechhold

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 28 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☐ Claim(s) \_\_\_\_\_ is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>3/12/04</u> .   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. **Claims 1-3, 9, and 12-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Dicke et al (US 4,886,232).**

Regarding claim 1, Dicke discloses a highway marker device comprising:

(a) a coil spring seen as either spring (60) or (62), having a first end (by mast (22)) and second end (at either axial end), wherein the coil spring is comprised of a plurality of windings around a spring axis as seen in Fig. 2,

(b) a marker post, seen as mast (22), connected with the first end of the coil spring (60) or (62), wherein the marker has a post axis and wherein the post axis is substantially perpendicular to the spring axis as Figs. 2 and 3 illustrate; and

(c) a mounting mechanism seen as adjustment bolts (86, 88) and upright members (32, 34) and bolt (26B) and nut (26C).

Regarding claim 2, Dicke discloses a primary mounting mechanism comprising a mounting bracket located adjacent to the second end of the coil

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spring, seen as shelf (80) with openings (82, 84) to adjustably mount the end strands (64, 68) through the use of bolts (86, 88).

Regarding claim 3, Dicke discloses a secondary mounting mechanism , which is seen as the upright members (32, 34) with bolt (26B) and nut (26C), which is spaced axially from the openings (82, 84) in the shelf (80).

Regarding claim 9, Dicke illustrates a marker flag attached to the mast (22) in Fig. 2.

Regarding claim 12 Fig. 2 of Dicke illustrates the spring axis as being substantially perpendicular to a direction of travel on the highway.

Regarding claim 13, Fig. 2 of Dicke illustrates the spring axis as substantially horizontal.

Regarding claim 14, Dicke discloses that there is an adjustment to maintain the mast vertical against a prevailing deflective force (Col 2, lines 20-24), which means that the springs will be more tightly wound upon vehicular contact.

Regarding claim 15, the mounting bracket is connected with the coil spring in Dicke as Fig. 2 illustrates.

Regarding claims 16 and 17, Dicke illustrates at least 9 and at least 12 windings in Fig. 1.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 4-8 and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dicke et al (US 4,886,232).**

Regarding claim 4, Dicke fails to disclose the primary mounting mechanism integrally formed with the coil spring. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the openings in the shelf (80) that cooperate with the bolts (86, 88) to be integrally formed with the coil spring (60) or (62), since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art. *Howard v. Detroit Stove Works*, 150 U.S. 164 (1893).

Regarding claim 5, Dicke fails to disclose the secondary mounting mechanism as a U-bolt which is sized to surround the coil spring. But Dicke does disclose upright members (32, 34) acting with bolt (26B) and nut (26C), the upright members (32, 34) being U-shaped (see Fig. 3), which cooperate with the end of the coil spring to maintain the axial alignment. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the upright members (32, 34) of Dicke to comprise U-bolts, since either provides the necessary structure to restrain movement of the coil.

Regarding claim 6, Dicke discloses a nut (26C) seen in Fig. 2 for connecting the upright member (32) or (34) with the object. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Dicke to include another nut, since a further means of restraint only duplicates the existing nut in Dicke, and it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Regarding claim 7, Fig. 2 of Dicke illustrates the secondary mounting mechanism as located adjacent to the first end of the coil spring.

Regarding claim 8, Dicke fails to disclose the marker post as integrally formed with the coil spring. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the marker post (22) to be integrally formed with the coil spring (60) or (62), since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art. *Howard v. Detroit Stove Works*, 150 U.S. 164 (1893).

Regarding claim 18, Dicke fails to disclose the marker post as integrally formed with the mounting bracket from a single piece of steel rod. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the marker post to be integrally formed with the mounting bracket from a single piece of steel rod, since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art [*Howard v. Detroit Stove Works*, 150 U.S. 164

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(1893)], and it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice (*In re Leshin*, 125 USPQ 416).

Regarding claim 19, Dicke fails to disclose a steel rod of between about 10 to about 20 mm in diameter. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the integral steel rod to be between about 10 to about 20 mm in diameter, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Regarding claim 20, Dicke fails to disclose the outer diameter of the coil spring. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the diameter of the coil springs (60) or (62) of Dicke to be at least about 50 mm, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F. 2d 272, 205 USPQ 215 (CCPA 1980).

**5. Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dicke et al (US 4,886,232) as applied to claim 3 above, and further in view of Clark et al (US 5,199,814).** Dicke fails to disclose at least a portion of the marker post being brightly coloured or having a luminous coating. Clark teaches a roadway delineator wherein the delineator post is provided with a reflective signage panel (18) to provide reflection of light, thus permitting the post to be readily visible under night driving conditions. Clarke

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also notes that the post and the panel may be of a suitable color enabling it to be readily visible during daylight conditions (Col 5, lines 47-54). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify at least a portion of the marker post of Dicke to be brightly coloured or having a luminous coating as taught Clark, since Clarke states in column 5, lines 47-54 that a reflective signage panel to provide reflection of light permits the post to be readily visible under night driving conditions, and a suitable color enables it to be readily visible during daylight conditions.

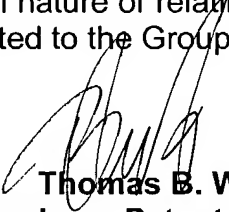
### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexandra Pechhold whose telephone number is (703) 305-0870. The examiner can normally be reached on Mon-Thurs. from 8:00am to 5:30pm and alternating Fridays from 8:00am to 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas B. Will, can be reached on (703)308-3870. The fax phone number for this Group is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1113.

  
**Thomas B. Will**  
**Supervisory Patent Examiner**  
**Group 3600**

AKP  
5/24/04